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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,739	05/10/2004	David A. Giardino	CP-5144US2	9744
7590 10/18/2005				
SCHMEISER, OLSEN & WATTS 3 Lear Jet Lane, Suite 201 Latham, NY 12110		EXAMINER CHUKWURAH, NATHANIEL C		
		ART UNIT 3721 PAPER NUMBER		
DATE MAILED: 10/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Tata

**Office Action Summary**

Application No.

10/772,739

Applicant(s)

GIARDINO, DAVID A.

Examiner

Nathaniel C. Chukwurah

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 56-64 and 67 is/are pending in the application.  
     4a) Of the above claim(s) 62-64 and 67 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 56-61 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 5/10/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 56-61 are rejected under 35 U.S.C. 102(b) as being anticipated by W.G. Mitchell et al. (US 2,727,598).

With regard to claim 56, Mitchell et al. discloses a method of using a modular control apparatus (12) comprising the steps of:

Providing a modular control apparatus (12), aligning, attaching and adjusting the output the modular control apparatus (see fig. 1) to a tool (11), and applying the tool to a workpiece (18, 19) as shown in Figure 1 wherein the apparatus is configured to shut off air flow to a tool after a selected time that torque is being applied by the tool (col. 5, lines 48-51, 55-59, 65-67).

With regard to claim 57, Mitchell et al. shows the modular control is attached and detached from the tool via screws 12a. Mitchell et al. further shows that the modular control apparatus can be aligned, attached, adjusted to a second tool and applied to the second tool to a workpiece.

With regard to claims 58 and 59, Mitchell et al. shows a step of providing fluid and/or air to the modular control apparatus through the fitting (21).

With regard to claim 60, Mitchell et al. shows a method of using a pneumatic modular control apparatus comprising the steps of: attaching a pneumatic modular control apparatus (12)

Art Unit: 3721

to a pneumatic tool (11) (see fig. 1) wherein the apparatus is configured to shut off air flow to a motor of tool in response to a selected time that torque is being applied by the tool (col. 5, lines 48-51, 55-59, 65-67); connecting a compressed-air supply channel (23) to an input port (23), channeling a compressed-air discharge from a discharge port to the tool's motor inlet, adjusting the control apparatus and applying the tool to the workpiece (18, 19) as shown in Figure 1.

With regard to claim 61, Mitchell et al. shows attaching a workpiece (18, 19) adapter (16 fig. 1) to at least drive shaft (14) of the motor of the tool.

### ***Response to Arguments***

Applicant's arguments filed 7/19/2005 have been fully considered but they are not persuasive.

With respect claim 56, applicant argues that Mitchell et al. does not teach or suggest a modular control apparatus configured to shut off air flow to a tool after a selected time that torque is being applied by the tool.

The Examiner disagrees with the applicant because Mitchell et al. does teach or suggest a modular control apparatus configured to shut off air flow to a tool after a selected time that torque is being applied by the tool.

The Examiner respectfully directs applicant to column 5, lines 48-51, 55-59, 65-67 which discussed that air flow is shut off to the tool after a selected time that torque is being applied by the tool. The selected time is zero at which torque is applied to the tool which meets the claimed limitation.

Art Unit: 3721

With respect claim 60, applicant argues that Mitchell et al. does not teach or suggest a modular control apparatus configured to shut off air flow to a tool in response to a selected time that torque is being applied by the tool.

Again, the Examiner disagrees with the applicant. See response to similar argument above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (571) 272-4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

Art Unit: 3721

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC

Oct. 5, 2005.

A handwritten signature in black ink, appearing to read 'Rinaldi I. Rada', with a long horizontal line extending to the right.

Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700